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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,050	07/07/2003	Eugene Terry Schurter	vimnp07072003	9793

7590 01/03/2007  
Eugene Terry Schurter  
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EXAMINER
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JACKSON, JAKIEDA R

ART UNIT	PAPER NUMBER
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2626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/616,050	SCHURTER, EUGENE TERRY	
	Examiner	Art Unit	
	Jakieda R. Jackson	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for generating the speech synthesis of text messages, speech recognition for the performance of Instant Messaging function and delivering text as part of an instant message to clients on electronic text messaging capable devices, does not reasonably provide enablement for a mechanism for the recording and delivery of voice as part of an instant message. The claim language "a mechanism for recording and delivery of voice *as part of* an instant message that *is part of* an instant messaging system...." seems to be a voice recording as an attachment to a text message, not generating the text message itself from speech, which appears to be an essential part of the invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the functional relationship

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between the recited steps "generating..." and "voice recognition..." and the apparatus "a mechanism for recording..." is unclear and considered indefinite since the resulting claims does not set forth the metes and bounds.

### ***Claim Objections***

5. The specification and claims are objected to because the term "voice recognition" is misused for what nowadays is called --speech recognition-- in the speech signal processing art. While "voice recognition" and "speech recognition" were both once used interchangeably to refer to spoken word recognition, nowadays these two terms are distinguished. The term "voice recognition" now denotes identification of who is doing the speaking (class 704/246), while "speech recognition" (or word recognition) denotes identification of what is being said (class 704/251). So, appropriate correction to the proper terms of art is required (e.g. page 2, line 24).

6. Claims 3 and the Specification is objected to because of the following informalities:

- Limitations (b) and (c) the word "equivelant" should be --equivalent--.
- Limitation (d) the word "ouput" should be --output--.
- Limitations (e) and (f) are repetitive.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-2 and 4-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (USPN 7,065,186) in view of Malik (PGPUB 203/0219104).

Regarding **claim 1**, Myers discloses a system and method for extending instant messaging applications to telephony devices using voice recording, voice streaming, voice recognition and voice synthesis comprising the steps of:

generating the speech synthesis of text messages (voice access to instant messaging; column 2, lines 6-19 with claim 1);

voice recognition for the performance of Instant Messaging functions, such as selecting a "buddy", changing status, sending a message, listening to a message (speech function to send and instant message; column 2, lines 55-66 with column 3, lines 4-5); and

delivery voice instant message to Instant Messaging clients on electronic text messaging capable devices and telephony devices (telephone) over networked systems such as the Internet (Internet), wireless networks, cellular networks, radio networks, and wireline networks (column 2, lines 6-19 and

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column 3, lines 28-36), but does not specifically teach a mechanism for the recording and delivery of voice as part of an instant message that is part of an Instant Messaging system.

Malik teaches voice message delivery over instant messaging comprising a mechanism for the recording (voice recording) and delivery (delivery) of voice as part of an instant message that is part of an Instant Messaging system (column 2, paragraph 0025-0026 with column 4, paragraph 0034-0036), to queue a message for later delivery.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Myers' system and method wherein it comprises a mechanism for the recording and delivery of voice as part of an instant message that is part of an Instant Messaging system, as taught by Malik, to provide means deliver the instant message to the user as soon as the user is present on the instant messaging network (column 2, paragraphs 0010-0011).

Regarding **claim 2**, Myers discloses a system and method wherein such system and method is applicable to Instant Messaging systems such as Microsoft Windows Messenger, Yahoo Messenger and AOL Messenger (desired hardware platform; column 2, lines 20-34 with column 3, lines 28-36).

Regarding **claim 4**, Myers discloses a system and method wherein such system and method further comprises:

(a) the use of one or more existing Instant Messenger service(s) account(s) (user logs onto account; column 2, lines 55-60);

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(b) the use of one of more newly created Instant Messenger service(s) account(s) (inherent in user logs onto account; column 2, lines 55-60);

(c) and the function of action as a client to one or more existing Instant Messenger service(s) (client providing access into instant messaging; column 1, lines 51-53).

Regarding **claim 5**, Myers discloses a system and method wherein such system and method further comprises;

(a) support of an individual Instant Messaging session as telephony device to electronic text messaging device and as telephony device to telephony device (telephone user and a data network that may include the Internet; column 2, lines 6-19);

(b) and multiple, simultaneous Instant Messaging sessions of both telephony device to electronic text messaging device and telephony device to telephony device without limitation to number of sessions or type of sessions (telephone network; column 2, lines 6-19).

9. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Myer in view of Malik and in view of Chemtob (USPN 7,124,164) in view of Zondervan et al. (PGPUB 2002/0059073), hereinafter referenced as Zondervan, and in further view of Jellinek (USPN 6,934,767).

Regarding **claim 3**, Myers in view of Malik discloses a system and method wherein such system and method further comprises:

(e) the playing, streaming, and replaying of a voice message as a sound file on an electronic text messaging capable device or telephony device (Myers; plays an instant message; column 3, lines 6-19), but does not specifically teach the method and system wherein it comprises emotions, conversions of instant messaging shorthand to both the phonetic equivalent and longhand translation and voice libraries to customize the speech synthesis.

Chemtob discloses a system and method comprising:

(a) the conversion of graphical emotion elements (Emoticons) to emotion sounds (Emotisounds) (emoticons; column 10, lines 50-61 and column 11, lines 5-10 with column 13, line 28 – column 14, line 14); and

(d) the selection of voice libraries to customize the speech synthesis output (customize feedback expressions; column 11, lines 5-10), to provide a variety of feedback expressions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Myers' in view of Malik's system and method wherein it comprises emotions and voice libraries to customize the speech synthesis, as taught by Chemtob, to facilitate participants to provide ongoing feedback and contain a variety of feedback expressions (column 10, lines 50-61).



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Myers in view of Malik and Chemtob disclose a speech Instant Messaging system and method, but does not specifically teach the conversion of Instant Messaging shorthand to their respective, phonetic equivalent.

Zondervan discloses a system and method wherein it comprises:

a conversion of Instant Messaging shorthand to their respective phonetic equivalent (replace certain words or abbreviations that may occur in the text, with phonetic spellings; column 15, paragraph 0326 and column 17, paragraph 0346), to provide custom pronunciation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Myers in view of Malik and Chemtob's system and method wherein it comprises a conversion of Instant Messaging shorthand to their respective phonetic equivalent, as taught by Zondervan, to provide customization (column 15, paragraph 0032).

Myers in view of Malik, Chemtob and Zondervan disclose a speech Instant Messaging system and method, but does not specifically teach that the translation of Instant Messaging shorthand to their respective, longhand equivalent.

Jellinek discloses a system and method wherein the translation of Instant Messaging shorthand to their respective, longhand equivalent (abbreviated substring relates to the expanded form; column 7, lines 4-12 with column 3, lines 34-50), produces an expanded input string that is version of the unexpanded input sting.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Myers in view of Malik, Chemtob and Zondervan's method and system and wherein it comprises translating of Instant Messaging shorthand to their respective, longhand equivalent, as taught by Jellinek, to reduce the character input problems by automatically expanding; (column 2, lines 15-29).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mendiola et al. (PGPUB 2002/0006803) disclose a method and system for inviting and creating accounts for prospective users of an instant messaging system.
- Diamant et al. (PGPUB 2002/0071539) disclose a method and apparatus for telephony-enables instant messaging.
- Wu et al. (PGPUB 20020023131) disclose voice instant messaging.
- Malik (USPN 7,123,695) discloses a voice message delivery over instant messaging.
- Creamer et al. (USPN 7,085,258) disclose instant messaging with voice conversation feature.
- Dodrill et al. (USPN 6,807,565) discloses instant messaging system using voice enables web based application server.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jakieda R. Jackson whose telephone number is 571.272.7619. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571.272.7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRJ

December 19, 2006



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